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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,004	01/02/2002	Daniel R. Baum	Shutterfly 04C001	8059

7590 12/19/2002

Bao Tran
Tran & Associates
3103 Glen Alto Court
San Jose, CA 95148

EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

~~10/035,004~~

10/038,004

Applicant(s)

BAUM, DANIEL R.

BECK, BRENT ALAN

04/30

Examiner

Yogesh C Garg

Art Unit

3625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): 112 Rejection, paragraph 1.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-21.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet


Continuation of 10. Other: See Continuation Sheet : The amendments made in claims 1 and 21 do not necessitate new search or consideration as the limitation of claim 5 is now added in claim 1 and the amendment in claim 21 "where at least one of the specified recipients is different from the orderer" is already implied when there are plurality of recipients. Further, the arguments filed by the applicant have been considered fully but are not persuasive for following reasons: With reference to the applicant's remarks regarding claims 1 and 21, "This capability is useful during the winter holiday season.....50 to 100 Cards online for their family members" (see page 5), examiner respectfully disagrees as claims 1 and 21 do not teach use of online or server. Further, with reference to the applicant's argument, "Shiota does not show the specifics of a single order that specifies multiple recipients" (see pages 6-8) the examiner does not agree. The inventions specified in claims 1 and 21 do not teach that it is a single order for all the recipients. Further Shiota teaches receiving order for multiple recipients as analyzed in Final Office Action.(see at least Shiota col.10, line 33-col.12, line 24

Applicant further argues that, "Shiota shows that a print service uploads images scanned from film.....there is no teaching in Shiota that a user directly uploads the images" (see page 9). Applicant's statement that his claimed application directly uploads images to a server (page 9) is not supported by claims 1, 5 and 6. Nowhere in claims 1, 5 and 6 applicant teaches uses of online or a server and as such it can be very well anticipated that a customer can go to a printing shop and upload the images there from a digital camera to a printing shop as disclosed in Shiota (see at least col.2, lines 34-42) as analyzed in the Final Office Action.

With regards to the applicant's arguments regarding claim 4 that Shiota does not anticipate claim 4, examiner would like to point out that Final Office Action did not state so. Final Office Action stated that combination of Shiota/Tackbarry discloses print parameters including one or more of print size, number of copies, print finish, and/or textual message, as analyzed in the Final Office Action..

With regards to claim 9, the examiner does not agree that Shiota does not show the web front-end user. Shiota does disclose a web front-end user (See at least FIG.1, FIG.6 which show the use of Internet-5 and WWW Browser 30, Central server 12, col.8, lines 17-31 teach the use of web page on the Internet, and col. 10, lines 30-41).

With regards to claims 11-12, the applicant argues that Shiota is silent if the order comprises a single transaction sequence and this sequence is terminated by a click of a "card order" button. The examiner does not agree. As analyzed in the Final Office Action, Shiota teaches that order is placed by using a single transaction and terminating the transaction by a button (see at least col.8, lines 17-30). Shiota's teaching of confirming the order through a predetermined input by clicking a thumbnail image of his/her picture corresponds to placing the order through a single transaction and terminating it by clicking the order button..


NATHAN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3800